

PATENT COOPERATION TREATY
PCT
INTERNATIONAL PRELIMINARY EXAMINATION REPORT
(PCT Article 36 and Rule 70)

Applicant's or agent's file reference 3595PTWO/AG/la	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/PEA/416)	
International application No. PCT/EP 03/07897	International filing date (day/month/year) 19.07.2003	Priority date (day/month/year) 19.07.2002
International Patent Classification (IPC) or both national classification and IPC B21B1/08		
Applicant DANIELI & C. OFFICINE MECCANICHE S.P.A.		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.

2. This REPORT consists of a total of 6 sheets, including this cover sheet.

☒ This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of 4 sheets.

3. This report contains indications relating to the following items:

I ☒ Basis of the opinion

II ☐ Priority

III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

IV ☒ Lack of unity of invention

V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

VI ☐ Certain documents cited

VII ☐ Certain defects in the international application

VIII ☐ Certain observations on the international application

Date of submission of the demand 18.02.2004	Date of completion of this report 12.10.2004
Name and mailing address of the international preliminary examining authority: <div style="display: flex; align-items: center;"> <div> European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465 </div> </div>	Authorized Officer Rechler, W Telephone No. +49 89 2399-2354



**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT**

International application No. PCT/EP 03/07897

I. Basis of the report

1. With regard to the elements of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17)*):

Description, Pages

1-9 as originally filed

Claims, Numbers

1-19 received on 13.09.2004 with letter of 07.09.2004

Drawings, Sheets

1/5-5/5 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
☐ the language of publication of the international application (under Rule 48.3(b)).
☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
☐ filed together with the international application in computer readable form.
☐ furnished subsequently to this Authority in written form.
☐ furnished subsequently to this Authority in computer readable form.
☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
☐ the claims, Nos.:
☐ the drawings, sheets:

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5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)

6. Additional observations, if necessary:

IV. Lack of unity of invention

1. In response to the invitation to restrict or pay additional fees, the applicant has:

- ☐ restricted the claims.
☐ paid additional fees.
☐ paid additional fees under protest.
☐ neither restricted nor paid additional fees.

2. ☒ This Authority found that the requirement of unity of invention is not complied with and chose, according to Rule 68.1, not to invite the applicant to restrict or pay additional fees.

3. This Authority considers that the requirement of unity of invention in accordance with Rules 13.1, 13.2 and 13.3 is

- ☐ complied with.
☒ not complied with for the following reasons:

see separate sheet

4. Consequently, the following parts of the international application were the subject of international preliminary examination in establishing this report:

- ☒ all parts.
☐ the parts relating to claims Nos. .

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	1 - 12
	No: Claims	13 - 19
Inventive step (IS)	Yes: Claims	
	No: Claims	1 - 19
Industrial applicability (IA)	Yes: Claims	1 - 19
	No: Claims	

2. Citations and explanations

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see separate sheet

Re Item IV:

The separate inventions/groups of invention are:

Claims 1 - 12 and 17 - 19 relate to a method and an apparatus for the production of rails and concern in particular the working sequence of the intermediate rolling stands.

Claims 13 - 16 relate to a method of producing rails and concern exclusively the finishing step.

They are not so linked as to form a single general inventive concept (Rule 13.1 PCT), because the special technical features relating to the intermediate rolling stands and the finishing operation are not the same and do not correspond to each other.

Re Item V:

1. Reference is made to the following documents:

D1: JP-A-03-086301; D2: SU-A-623 593; D3: US-A-3 583 193

2. The present application does not meet the requirements of the PCT, because the subject matter of claims 1 - 12 does not involve an inventive step in the sense of Article 33 (3) PCT.

Document D1, which is considered to represent the most relevant state of the art with respect to claim 1, discloses (cf. figures 2 and 7) a method for the production of rails from which the subject matter of claim 1 only differs in the sequence of the rolling steps. This feature, however, is merely one of several straightforward possibilities from which the skilled person would select, in accordance with circumstances, without the exercise of inventive skill, in order to solve the problem posed, in particular as it is already known from document D1, that the first pass of the first universal rolling stand is an empty pass.

Furthermore, the arguments of the applicant that the characterising features of the independent claim 1 were not known cannot be accepted in view of figures 2 and 7 of document D1, which render it highly unlikely that these features are not present. Moreover, the characterising features of claim 1 rather depend on the length of the bar than on the production method and the placement of the rolling stands.

Dependent claims 2 - 12 do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT in respect of inventive step, because in these claims merely further details or slight changes in the method of claim 1 are defined which come within the scope of the customary practice followed by persons skilled in the art, especially as the advantages thus achieved can readily be foreseen. Consequently, the subject matter of claims 2 - 12 also lacks an inventive step.

3. The present application does not meet the requirements of the PCT, because the subject matter of claims 13 - 19 is not new in the sense of Article 33 (2) PCT.

Documents D2 and D3 both disclose a method for the production of rails including all features of claims 13 - 16, in particular the features relating to the design of the universal finishing mill.

4. Document D1 discloses a plant with all features of claims 17 - 19, see in particular figures 2 and 7. Thus, the arguments of the applicant that the characterising features of the independent claim 17 were not known cannot be accepted in view of figures 2 and 7 of document D1, which render it highly unlikely that these features are not present. Moreover, the characterising features of claim 17 rather depend on the length of the bar than on the production method and the placement of the rolling stands.

Further Remarks:

1. Contrary to the requirements of Rule 5.1(a)(ii) PCT, the relevant background art disclosed in the documents D1 - D3 is not mentioned in the description, nor are these documents identified therein.
2. The statement in the last two lines of the description is inconsistent with the definition of the matter for which protection is sought, contrary to Article 6 PCT. Therefore this paragraph should have been deleted because even a rectified statement would have to be regarded as obviously irrelevant or unnecessary pursuant to Rule 9.1 (iv) PCT.